

**REMARKS/ARGUMENTS**

Re-examination and favorable reconsideration in light of the following comments are respectfully requested.

Claims 1 - 14 are pending in the application. Currently, no claim has been allowed.

In the office action mailed February 23, 2006, the Examiner objected to the specification on the grounds that the specification does not clearly explain the diamond mounting direction in paragraph [0019]. The Examiner contends that the specification does not describe how the locations of the coordinates are defined so that one of ordinary skill in the art can make and use same. That is, whether the coordinates are defined relative to the shank axis or the diamond tip axis. Once again, Applicant points out that this contention is without merit. One of ordinary skill in the art reading the specification, in particular paragraph [0019] and looking at FIGS. 2 and 3 would understand that the location of the coordinates is defined relative to the shank axis. One of ordinary skill in the art would understand that this is the case because of the depiction of the axis 24 in FIG. 2. One of ordinary skill in the art would also understand that the crystallographic direction  $\langle 17,12,24 \rangle$  is the direction in which the diamond is to be mounted, which direction is aligned with the shank axis. One of ordinary skill in the art would readily understand all of this from paragraph [0019] and from FIG. 3. In fact, in Applicant's opinion, all one of ordinary skill in the art needs is FIG. 3. The questions set forth by the Examiner in the first full paragraph on page 6 of the office action have nothing to do with what has been disclosed in the present application and show that the problem is with the Examiner and not with the disclosure. With respect to the

Examiner's comments in the second full paragraph on page 6 of the office action, the coordinates of the direction are clearly defined in the specification. See FIG. 3 and see paragraph [0019]. Nothing more is needed.

Claims 1 - 14 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that regarding claims 1, 13, and 14, it is unclear whether Applicant claims atomic arrangement of the atoms in the diamond tip 16 or the angle of the diamond tip 16 with respect to the shank axis 24 or the angle of the outer surface of the diamond tip with respect to the diamond tip's axis or the diamond tip's base. The Examiner contends that there is insufficient information as to the specific intrinsic crystallographic direction and the angle to what it is. That is, it is not clear what the  $\langle 17, 12, 24 \rangle$  direction represents. The Examiner further states that "it is not clear why mounting of any diamond tip to an indenting tool would not inherently meet the limitation of the direction of the diamond tip, since the Applicant's diamond tip is very similar to other diamond tips which both align with the axis of their shank and both have conical shape."

With regard to the latter statement, this is not a basis for making a rejection under 35 U.S.C. 112, first paragraph. It may form a basis for a prior art rejection, but it certainly does not form the basis for a non-enablement rejection. The fact that Applicant's diamond tip is similar to others goes to prior art, not to enablement.

With regard to the enablement rejection, the Examiner has not made out a *prima facie* case of non-enablement since there is no statement as to why one of ordinary skill in the art having the teachings contained in the specification and drawings could

not make and use the claimed invention. As stated in *In re Armbruster*, 185 USPQ 152, 153 (CCPA 1975), quoting from *In re Marzocchi*, 169 USPQ 367, 369-70 (CCPA 1971), "it is incumbent upon the Patent Office, whenever a rejection on this basis [lack of enablement] is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." The Examiner has not provided any evidence or any reasoning why one of ordinary skill in the art having the instant disclosure before him could not make or use the claimed invention. The mere fact that the Examiner is having difficulty understanding the claimed subject matter or has "doubts" is not a basis for a lack of enablement rejection. The standard is one of ordinary skill in the art and the Examiner is not one of ordinary skill in the art. In Applicant's opinion, the specification contains sufficient guidance so that one of ordinary skill in the art could make and use the claimed invention without undue experimentation. See Applicant's comments regarding the objection to the specification. Even if some experimentation were needed, and Applicant believes none is needed, such experimentation would be permissible. See *Ex parte Jackson*, 217 USPQ 804, 807 (BPAI 1982); also see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986). Where a specification such as the instant one provides guidance in selecting parameters that would yield the claimed result as well as a lot of other details, it is fair to conclude that the experimentation required to make a particular embodiment is not "undue". See *In re Colianni*, 195 USPQ 150, 153 (CCPA 1977); also see *In re Wands*, 8 USPQ2d 1400, 1406 (Fed. Cir. 1988). For these

reasons, the rejection under 35 U.S.C. 112, first paragraph should be withdrawn.

With regard to the rejection of claims 1 - 6, and 8 - 14 on anticipation grounds over U.S. Patent No. 6,051,079 to Anderson, it is well settled that in order for a reference to anticipate a claim, it must contain all the features called for in the claim. Anderson does not teach or suggest a diamond being mounted to the tip and within 8 degrees of a <17,12,24> direction as claimed in claims 1, 13, and 14. Anderson is silent on crystallographic orientation of the diamond. What an Examiner considers the reference to show is not relevant. What is significant is what the reference discloses to one of ordinary skill in the art. Anderson does not disclose the claimed invention.

The Examiner's comments on page 7 of the final rejection are noted; however, it is not what the Examiner considers the reference to say that determines whether the reference anticipates the claimed invention. Rather, it is what the reference teaches one of ordinary skill in the art that determines whether the reference is an anticipatory reference. As noted above, the Anderson patent does not teach or suggest all of the limitations of claim 1.

Claims 2 - 6 and 8 - 12 are allowable for the same reasons as their parent claim(s) as well as on their own accord.

With regard to the rejection of claim 7 on obviousness grounds, claim 7 is allowable for the same reason as well as its own accord. Further, the mere fact that something is known in the art is not a basis for concluding something is obvious. Even now, with the information disclosure in hand, the Examiner provides no secondary reference that teaches or suggests the use of a synthetic single crystal diamond. Still further, the

Examiner has not provided any statement as to why one of ordinary skill in the art would be motivated to use a synthetic single crystal diamond. Thus, the rejection is fatally flawed.

For the foregoing reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, the Examiner is hereby invited to contact Applicant's attorney at the telephone number listed below.

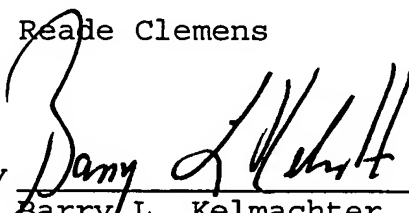
A notice of appeal is appended hereto in the event that the Examiner maintains the rejections of record.

The Director is hereby authorized to charge the notice of appeal fee of \$500.00 to Deposit Account No. 21-0279. Should the Director determine that an additional fee is due, he is hereby authorized to charge said additional fee to said Deposit Account No. 21-0279.

Respectfully submitted,

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I, Rhonda Longo, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on May 23, 2006.

